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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/866,987 | 05/30/2001 | Gregory D. Plowman | 038602-1180 | 6720 |

22428 7590 09/24/2002

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

NASHED, NASHAAT T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1652

10

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Office Action Summary

Application No.
09/866,987

Applicant(s)
Plowman et al.

Examiner
Nashaat T. Nashed

Art Unit
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO 892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other

Claims 1-32 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- (A) Claims 1-5 and 26-32, drawn to nucleic acid encoding the protein phosphatase of SEQ ID NO: X, vector, and host cell:
Groups 1-5 X = 6-10, respectively, classified in Class 536, subclasses 23.2.
- (B) Claims 6-8, drawn to the protein phosphatase of SEQ ID NO: X:
Groups 6-10 X = 6-10, respectively, classified in Class 435, subclass 196.
- (C) Claims 9-11, drawn to antibody raised against the protein phosphatase of SEQ ID NO: X and a method of use:
Groups 11-15 X = 6-10, respectively, classified in Class 530, subclass 387.1.
- (D) Claims 12-13, drawn to a method of identifying a compound that bind to the protein phosphatase of SEQ ID NO: X:
Groups 16-20 X = 6-10, respectively, classified in Class 530, subclass 387.1.
- (E) Claims 14-20, drawn to a method of treating diseases by administering to a patient a modulator of the protein phosphatase of SEQ ID NO: X:
Groups 21-25 X = 6-10, respectively, classification is unknown.
- (F) Claims 21-25, drawn to a hybridization method of detecting the protein phosphatase of SEQ ID NO: X (presumed to be to detect the nucleic acid encoding the polypeptide):
Groups 26-30 X = 6-10, respectively, classification is unknown.

The inventions are distinct, each from the other because of the following reasons:

The nucleic acid of Groups 1-5, the polypeptide of Groups 6-10, and the antibody of Group 11-15 are independent chemical entities and require different searches in the patent and non-patent literature.

Inventions of Groups 1-5 and those of the methods of Groups 16-25 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together because the methods of Groups 16-25 do not utilize the nucleic acid of Groups 1-5.

Inventions of Groups 1-5 and the methods of Groups 26-30, respectively, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acid of Groups 1-5 can be utilized in other methods such as in a recombinant methods to make the respective protein phosphatase.

Other than the nucleic acid encoding the protein phosphatase used in one of the methods of Groups 26-30, the nucleic acids of Groups 1-5 and the hybridization methods of Groups 26-30 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, nucleic acid of Groups 1-5 are not utilized by any of the methods of Groups 26-30.

Inventions of Groups 6-10 and the methods of Groups 16-20, respectively, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the protein phosphatase of Groups 5-10 can be utilized in other methods such as in method to make the antibodies specific for protein phosphatase of Groups 6-10.

Other than the protein phosphatase used in one of the methods Groups 16-20, the protein phosphatases of Groups 6-10 and the methods of Groups 16-20 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the protein phosphatases of Groups 6-10 are not utilized by any of the methods of Groups 16-20.

The protein phosphatases of Groups 6-10 and the methods of Groups 21-30 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the protein phosphatases of Groups 6-20 are not utilized by any of the methods of Groups 21-30.

The antibody specific for the protein phosphatases of Groups 11-15 and the methods of Groups 16-30 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the

antibody specific for the protein phosphatases of Groups 11-15 are not utilized by any of the methods of Groups 16-30.

Inventions of Groups 16-30 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are independent methods having different steps and use different reagents.


Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is (703) 305-6586. The examiner can normally be reached Monday, Tuesday, Thursday and Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone numbers for this Group are (703) 305-3014 and (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Nashaat T. Nashed, Ph. D.
Primary Examiner